

REMARKS

In accordance with the foregoing, Applicant herein amends claims 1-30 and add new claims 31-40. Thus, following entry of the amendments contained herein, claims 1-40 stand pending examination on the merits. Entry and favorable consideration of the amendments tendered herewith is earnestly solicited so that the presently pending claims may pass to timely issuance as U.S. Letters Patent.

The following remarks are respectfully submitted

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I. Claim Rejections Under 35 U.S.C. §103

Claims 1-3, 10-12 and 27 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Pat. No. 6,261,434 to Melody et al. (Melody) in view of U.S. Pat. No. 6,235,181 to Kinard et al. (Kinard).

Applicant respectfully suggests that said claims are in fact patentably distinct from the cited art and thus, this ground of rejection should be properly withdrawn. Applicant avers that the Examiner has failed to lodge a *prima facie* obviousness rejection against claims 1-3, 10-12 and 27 in that neither Melody nor Kinard contains any suggestion, teaching or motivation to combine the references. In fact, Melody and Kinard are commonly assigned and both Mr. Melody and Mr. Kinard are co-inventors on both patents, yet neither reference includes any disclosure, depiction or suggestion regarding the presently claimed methods and apparatus for anodizing. In addition, independent claim 1 stands amended herewith to include a limitation regarding the temperature of the

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formation electrolyte during anodization; to wit, wherein said anodizing electrolyte is maintained at about 40 degrees Celsius or less during the anodizing process.

Applicant suggests that neither Melody nor Kinard includes such a limitation; in fact, Melody and Kinard teach away from the notion of such a relatively low temperature electrolyte for high voltage anodization (i.e., Kinard provides for approximately 150 degree Celsius formation electrolyte while Melody provides for 80 to about 90 degree Celsius formation electrolyte).

As stated by the Court of Appeals for the Federal Circuit in Ecologchem, Inc., v. Southern California Edison Company, decided September 7, 2000:

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In In re Dembiczak, we noted that:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.

In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). We "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988).

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. **"Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight."** Id. (Emphasis Added.)

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d

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1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). The same principle applies to invalidation. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Therefore, since Melody and Kinard cannot be shown to include any teaching or suggestion to combine the disparate disclosures of each and thus cannot support a *prima facie* obviousness rejection, Applicant respectfully requests that the Examiner withdraw the rejection posed against dependent claims 13, 21 and 30.

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III. Allowed Claims

The Examiner has indicated that claims 4-9, 13-26 and 28-30 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

However, for the above and foregoing reasons, Applicant respectfully submits that all previously pending claims 1-30 stand in condition for allowance due to the fact that the a defective combination of references was lodged against the rejected claims (i.e., Melody and Kinard). Thus, the dependency of claims 1-30 has not been amended herein and Applicant again respectfully requests the Examiner to withdraw the rejection of claims 1-3, 10-12 and 27 so that claims 1-30 may pass to timely issuance as U.S. Letters Patent.

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In addition, Applicant has herein added new claims 31-40, including independent apparatus claim 31 and independent software medium claim 38. Since these claims largely parrot the claim limitations of select ones of the method claims Applicant asserts that no these claims are properly

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IV. Conclusion

There being no further outstanding objections or rejections, it is submitted that the claims 1-40 of the application all stand in condition for allowance. An early action to that effect is courteously solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references. For example, Applicant has amended claims 1-30 for convenience only (e.g., rearranging the preamble from "[t]he method of" to "[a] method according to" and also - for select claims - by restating the phrase "potential pulses" to "pulses of electrical potential"). Likewise, Applicant noted that several claims appeared to use different phraseology for a common element; namely, "target voltage" was sometimes inadvertently referred to as "target formation potential" and thus, Applicant herein amends each occurrence to commonly employ "target voltage" (as recited in independent claim 1). Applicant asserts that such amendments in no way narrow the scope of the claims and are presented herewith as desirable from the subjective standpoint of Applicant.

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Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned attorney to attend to these matters.

Respectfully submitted,

Date:

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